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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,921	07/11/2003	Shin Hirayama	240292US0CONT	2418
22850	7590	10/19/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			COE, SUSAN D	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1654

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,921

Applicant(s)

HIRAYAMA ET AL.

Examiner

Susan D. Coe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-28 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-28 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed July 26, 2004, has been received and entered. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
2. Claim 29 has been cancelled.
3. Claims 17-28 and 30 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17-28, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001046051 A.

Applicant's claims are drawn to using D-cysteinolic acid or a sea lettuce extract to suppress obesity.

JP '051 teaches compositions comprising D-cysteinolic acid extracted from sea lettuce using water. The water temperature is 50 to 70 degrees C (see paragraph 42 of the English translation). JP '051 teaches that the D-cysteinolic acid is used as a pharmaceutical to reduce blood cholesterol (see paragraph 4 of the English abstract). The reference does not specifically state that the composition suppresses obesity. However, the reference is considered to inherently anticipate the claims because both the reference and the claims are administering the same composition to the same patient. The claims are drawn to a prophylaxis for obesity. Any person

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has the potential to become obese. Thus, since anyone can become obese, on administering the composition in the manner taught by JP '051, the same composition has been administered to the same patient. Thus, the administration taught by JP '051 would inherently have to have the same effects on the body if applicant's invention functions as claimed.

Claim Rejections - 35 USC § 103

5. Claims 17, 18, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 03118319 A2 in view of US Pat. No. 4,220,653 for the reasons set forth in the previous Office action.

All of applicant's arguments regarding this ground of rejection have been fully considered but are not persuasive. Applicant argues that the D-cysteinolic acid derivatives taught by JP '319 would not be expected to function equivalently because D-cysteinolic acid contains a sulfonic acid group that is "believed to serve an important role" in the treatment or suppression of obesity. The derivatives do not contain this sulfonic acid group; thus, D-cysteinolic acid would not be expected to function equivalently.

However, as discussed in MPEP section 2144.09, "The presumption of obviousness based on a reference disclosing structurally similar compounds may be overcome where there is evidence showing there is no reasonable expectation of similar properties in structurally similar compounds." Applicant has not shown why there would be no expectation of similar properties. Applicant only states that one functional group is "believed" to be important, but offers no arguments to support why it is important. Thus, due to the significant structural similarity

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between D-cysteinolic acid and its derivatives disclosed by JP '319, a person of ordinary skill in the art would reasonably expect the two to function equivalently.

Regarding US '653, applicant argues that the reference does not specifically teach treating obesity because the reference only teaches that gastric juice inhibitors reduce appetite and food intake. Applicant states "gastric juice secretion inhibitors act to cause subjects to eat less food. This is different from suppressing or treating obesity." However, applicant's attention is directed to the title of the patent which specifically states that the reduction of appetite facilitates weight loss in a person suffering from excessive weight (i.e. obesity). Clearly, the reference teaches that a reduction in food intake will result in weight loss. Not only does the reference teach this, but any person in the art would recognize that calorie reduction will result in loss of weight. In addition, such a calorie reduction would also prevent an average weight person from gaining more weight and potentially becoming obese.

Applicant also argues that the mechanism of action of the claimed invention is different from reducing the intake of food. However, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

6. Claims 21, 22, 24-26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 03118319 in view of US Pat. No. 4,220,653 as applied to claims 17, 18, 20, and 30 above, and further in view of JP 2001046051 A for the reasons set forth in the previous Office action.

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Applicant argues against this rejection for the same reasons as discussed above in paragraph 5. Thus, the response to these arguments is found above.

7. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Coe whose telephone number is (571) 272-0963. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30 and on alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.


Susan D. Coe, Examiner
October 13, 2004